FILE COPY

Office - Supreme Court, U. S.
FILED
MAY 17 1947
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM 1946.

Nos. 1273 and 1274

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRITS OF CERTIORARI.

JOHN D. BLACK,
ALBIN C. AHLBERG,
Counsel for Respondent.

ROSS O. HINKLE,
LEON F. SHACKELL,
Of Counsel.

THE DUNTHORP-WARREN PRINTING COMPANY, 310 WEST JACKSON, CHICAGO

INDEX.

	PAGE
Supplemental Statement of Matter Involved	1
The background of the Bronaugh & Potter patent	4
The court below correctly interpreted the doctrine of *Halliburton* v. *Walker* and properly applied that doctrine to the claims in suit	10
The Circuit Court of Appeals, on its own motion, could notice a plain error in the record, resulting from the failure of the trial court to instruct the jury on a vital issue of the case	13
The court below correctly ruled that no instruction was given on the issue of "clarity of phraseology" under Rev. Stat. 4888	16
Conclusion	18

Table of Cases.

Blanos v. Kulesva, 107 Conn. 476, 481 17
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U. S. 405 .....10, 12, 13
General Electric Co. v. Wabash Appliance Co., 304 U. S. 364, 371 12
Gilchrist Co. v. Kar-Lac Co., 29 F. (2d) 153, 154 ....10, 12
Halliburton Oil Well Cementing Co. v. Walker, 329 U. S. 1, 9 .....2, 10, 11, 12, 13, 18
Humes v. United States, 170 U. S. 210, 211-2 13
Klein v. Russell, 86 U. S. 433, 463 13
Minnesota Mining & Mfg. Co. v. International Plastic Corp., 159 F. (2d) 554, 558 .....10, 12
Pennock v. Dialogue, 27 U. S. 1, 15 13
Royal Insurance Co. v. Miller, 199 U. S. 353, 369 15
Texas & Pacific Ry. Co. v. Volk, 151 U. S. 73, 78 13
United Brotherhood of Carpenters and Joiners of America v. United States, 91 L. Ed. (Adv. Ops.) 705, 714 .....14, 17

Statutes Cited.

Rev. Stat. 4888; 35 U. S. C. A. § 33 .....2, 10, 13, 15, 16

IN THE

Supreme Court of the United States

OCTOBER TERM 1946.

Nos. 1273 and 1274.

REFRIGERATION PATENTS CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

POTTER REFRIGERATOR CORPORATION,
Petitioner,

against

STEWART-WARNER CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRITS OF CERTIORARI.

SUPPLEMENTAL STATEMENT OF MATTER INVOLVED.

Respondent considers petitioners' Summary Statement of the Matter Involved to be inadequate fully to inform this Court of the issue decided by the court below. We shall,

therefore, supplement petitioners' statement with such matters as seem to us to be essential.

Although respondent had presented to the court below the additional defenses that, as a matter of law, the two patents here involved were invalid because they were anticipated (R. Vol. I, pp. 6, 64-65, 85, 98, 99) and disclosed no invention over the prior art (R. Vol. I, pp. 5-6, 65, 85, 99-100), and were not infringed (R. Vol. I, pp. 5, 54), the court below decided that the patents were invalid on the additional defense that the claims in suit fail to comply with the requirements of Rev. Stat. 4888; 35 U. S. C. A., Sec. 33 (R. Vol. I, pp. 6-7, 65, 66, 100).

The opinion states (R. Vol. IV, p. 2781):

> "We have studied the claims of the patents in suit, the points raised in appellees' brief on the issue of clarity of phraseology, and the Supreme Court's opinion in the Halliburton case, *supra* [329 U. S. 1]. We conclude there has been such a want of clarity that, as a matter of law, the patents must be held invalid."

Before stating this conclusion, the opinion said (R. Vol. IV, p. 2779):

> "We are at once confronted by the very recent opinion of the Supreme Court in the case of *Halliburton Oil Well Cementing Company* v. *Walker,* decided November 18, 1946 [329 U. S. 1]. There the Court held a patent invalid for failure to comply with Rev. Stat. 4888, 35 U. S. C. A., Sec. 33. That statute requires the patentee to state his invention in '*such full, clear, concise and exact terms* as to enable any person skilled in the art or science to which it appertains * * * to make, construct, compound, and use the same; and in the case of a machine, *he shall explain the principle* thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and *he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his* invention or discovery * * *,"

The issue of "clarity of phraseology" was decided—could be decided—only with a knowledge of the background of the patents in suit and of the specific question which the court below decided adversely to them. Petitioners seem studiously to have avoided giving this Court that essential background. The petition fails to afford any clear idea of the subject matter involved, the nature of the alleged inventions purported to be covered by the claims in suit and the peculiar character of those claims. Without an understanding of these matters we believe it will not be possible for this Court to appraise the "Questions Presented" or the "Reasons Relied on for the Allowance of the Writs", or the "Specification of Errors" or the discussion thereof appearing either in the petition or in this brief in opposition. We therefore briefly sketch this necessary background.

The patents in suit relate to mechanical household refrigerators. The principal patent of the two involved is that of Bronaugh & Potter No. 2,056,165 (Petition, p. 9); and since the petition discusses only a peculiarity of one of the several claims in suit from this patent, we shall likewise limit our consideration to the Bronaugh & Potter patent. Obviously petitioners deliberately selected the critical expression of claim 10 (R. Vol. IV, p. 2690) of this Bronaugh & Potter patent as best suited to their purposes.* (Petition, p. 9.) Inability to demonstrate the soundness of their position as to this chosen expression will necessarily carry with it failure also as to the other claims in suit.

*"A non-frosting coil in the cooling compartment" is designated as element 6 in the claim chart and discussion in the opinion of the court below. (R. Vol. IV, pp. 2783-2786.)

The Background of the Bronaugh & Potter Patent.*

Refrigeration is not, as commonly believed, putting cold into something; on the contrary refrigeration is taking away or absorbing heat to produce cold (R. Vol. II, p. 1371).

In the old fashioned ice box the cake of ice does not throw out cold to its surroundings; on the contrary the cake of ice produces cold in its surroundings by taking away or absorbing heat therefrom. In the process of absorbing heat, the ice changes state from solid to liquid,—that is, it melts.

In mechanical refrigeration, a volatilizable chemical substance called a refrigerant takes the place of the cake of ice as the heat absorbing agent. Cooling is effected by causing the refrigerant to change state from a liquid to a vapor (*i.e.*, to evaporate or volatilize) because in so changing state, large quantities of heat are absorbed (R. Vol. I, p. 131; Vol. II, p. 1374). The refrigerant is circulated by a motor driven pump (compressor) through a closed circuit which includes a coil of tubing in the chamber to be chilled, and the pump and a condenser outside of the chamber (R. Vol. II, pp. 1437, 1442). The pump or compressor forces the refrigerant under pressure in liquid form through a pressure reducing or expansion valve into the coil (R. Vol. II, p. 1438). The reduction in pressure causes the liquid refrigerant to evaporate or volatilize and expand in the coil and thereby absorb heat from the chilling chamber and things stored therein (R. Vol. I, p. 131). The temperature at which the refrigerant evaporates or volatilizes in the coil and absorbs heat is determined by the setting of the expansion or pressure reducing valve; the lower the pressure, the lower temperature at which the heat is absorbed. These

* Fig. 1 of the Bronaugh & Potter patent and of the Anderson patent hereinafter referred to are reproduced in a folder at the back of this brief.

cooling coils are commonly known by the interchangeable terms evaporator, expander or chilling element (R. Vol. I, p. 133; Vol. II, p. 1389). The pump also sucks the heat-laden vapor from the cooling coil, compresses it and passes it on to the condenser where the absorbed heat is dissipated to the atmosphere and thereby the refrigerant is turned into a liquid again ready to be pumped back through the expansion valve into the cooling coil (R. Vol. I, p. 136; Vol. II, p. 1437). This cycle of evaporation to absorb heat from the chilling chamber and compression and condensation to dissipate the absorbed heat to the outside atmosphere is repeated as long as the motor drives the compressor pump (R. Vol. II, pp. 1442-3). A thermostat in the chilling chamber acts automatically to start the motor when the temperature in the chamber rises to a predetermined maximum, and to stop the motor when the temperature falls to a predetermined minimum (R. Vol. II, p. 1443). Such mechanical refrigerating systems have been known and extensively used for about 50 years (R. Vol. II, p. 1391).

In the conventional household mechanical refrigerator the cooling coil (or evaporator or expander or chilling element) is located in the food preserving chamber and usually formed about shelves for holding ice cube trays.

The refrigerators involved in these actions differ from the conventional one-chilling-element type in that the cabinet is divided by a heat insulating partition into two completely separated compartments, one to be maintained below freezing and the other to be maintained at a refrigerating temperature above freezing, each compartment having its own individual chilling element.

This idea of a two-compartment two-temperature refrigerator was not new with Bronaugh & Potter; it was ten years old before they entered the field.

In 1922 August P. Anderson Patent No. 1,439,051 was granted on just such a refrigerator (R. Vol. IV, pp. 2712 to 2718, and see folder at back of brief).

This Anderson patent refrigerator, like the Bronaugh & Potter patent refrigerator has in a single cabinet a machine compartment 20 housing a motor, compressor and condenser, a "sharp freezing" compartment 7 chilled by coil 35 and a larger "refrigerating compartment" 6 chilled by coil 40. The sharp freezing and refrigerating compartments are insulated from each other, from the machine compartment and from the outside atmosphere. The refrigerant circuit or "expansion line" includes a pressure reducing or expansion valve 33 "at the point of entrance into the freezing compartment" 6 and the coils or expanders 35 and 40 individual to the "sharp freezing" and "refrigerating" chambers, respectively, are in series in that expansion line. In this old Anderson patent there is also a thermostat in the upper warmer "refrigerating" compartment, responsive to the temperature in that compartment, to start and stop the compressor motor when the temperature rises to a predetermined maximum and falls to a predetermined minimum.

The two-chamber, two-temperature refrigerator system of the Anderson 1922 patent contains the same combination of the same elements (except one) connected together and cooperating in precisely the same way as in the Bronaugh & Potter patent refrigerator. On this point the court below said

> "* * * there was here no *new* combination of elements. There was at best an old combination with some of elements somewhat varied," (R. Vol. IV, p. 2783).

The only differences between the refrigerators of the Bronaugh & Potter patent and the prior Anderson patent are (1) the substitution in the warmer compartment of a so-called "finned coil" * for the bare (unfinned) tubing of

* Although the Bronaugh & Potter patent fails clearly to show and does not describe at all a "finned" coil, the plaintiffs did use a finned coil in refrigerators built by or under license from them between 1932 and 1938. In these finned coils the tubing was pro-

Anderson, and (2) the substitution of thicker insulation around the colder compartment than around the warmer compartment instead of insulation of the same thickness around both compartments as in Anderson.

The substitution in the upper warmer compartment of a so-called finned coil for the bare tubing of Anderson is alleged to preserve food longer without drying out and to eliminate the necessity for periodic defrosting. The use of thicker insulation around the freezing compartment than around the upper warmer compartment, rather than the same thickness of insulation around both compartments, is alleged to contribute to these and other beneficial results.

The "exact point of novelty" or the "most crucial element" is therefore merely the substitution of one kind of chilling element or expander for another kind in the upper cooling chamber as to some claims in suit; it is the difference in thickness of insulation around the two compartments as to other claims in suit.**

Instead, however, of describing this "exact point of novelty" or this "most crucial element" in "terms of its own physical characteristics or its arrangement in the new combination apparatus", the claims in suit describe this so-called finned coil "in terms of what it will do" under certain conditions but what it will *not* do under other operating conditions. In other words, the most crucial element or exact point of novelty is defined in terms of function or result. Not only that, but there is no description or direction whatsoever, either in the specification or in the

---

vided with laterally projecting plates or "fins" to enlarge the exposed surface.

Respondent's refrigerator did not use finned coils.

** The arguments made by the Bronaugh & Potter attorneys before the Patent Office which finally lead to the allowance of the claims in suit show conclusively that these two elements or features are and were conceded to be the "exact point of novelty" or the "most crucial element" (For example, see Bronaugh & Potter file wrapper p. 81 and 83; R. Vol. III, pp. 2292, 2294).

claims, regarding the operating conditions under which the coil will produce the result required, or, conversely, regarding the operating conditions under which the coil will fail to produce the results required.

Thus instead of describing a finned coil, the patent specification does not even contain this expression or anything resembling or equivalent to it.

The claims in suit are equally deficient and vague.

Claim 18 describes the coil as:

> "means constructed and arranged to maintain the humidity in the warmer chamber at a relative value of at least 100 per cent at 32 degrees Fahrenheit" (R. Vol. IV, p. 2691).

Claims 12, 14 and 16 describe it as:

> "means constructed and arranged to maintain the external surface temperature of the expander in the warmer chamber above said freezing point" (R. Vol. IV, pp. 2690-1).

And claim 10 describes it as:

> "a non-frosting coil in the cooling compartment" (R. Vol. II, p. 2690).

That these three expressions are equivalent in meaning and equally functional is established beyond dispute by the testimony of the experts for both parties. Thus the petitioners' expert testified that

> "a coil is non-frosting when it is operated one way, and the same coil would be a frosting coil if it was operated another way" (R. Vol. 1. p. 232).

He further testified that these three expressions

> "are discussing the same operation, the same functions" (R. Vol. 1, p. 233).

In short there is no such thing as a "non-frosting coil" *per se;* "non-frosting" is not a physical characteristic of any coil. Whether any coil (even a finned coil) is frosting or non-frosting depends upon how it is operated. Petitioners' expert testified that:

> "If you don't want the frost to form on the coil 25, coil structure 25 of Figures 1 and 2 of Bronaugh and Potter, you so set the thermostat that the thermostat will stop the motor before the refrigerating machinery is effective to pull the temperature of the coil system down to the point that frost forms" (R. Vol 1, p. 199-200).

In their main brief before the Circuit Court of Appeals, however, petitioners argued that three variable factors (instead of only one as their expert testified) were contributory to the production of a non-frosting coil, (1) "special shaping" (e. g., finning), (2) "special thermostatic setting" (the only factor mentioned by their expert), (3) "selected refrigerant", and (4) "selected inside coil pressure" (i. e., expansion valve adjustment).

Likewise instead of claiming thicker insulation around the freezing compartment than around the warmer cooling compartment, claims 10 and 11 describe this most crucial element as:

> "the thermal insulation of the compartments being relatively so (or "so relatively") proportioned as to admit a greater inflow of heat into the cooling compartment than into the freezing compartment" (R. Vol. IV, p. 2690).

Thus claims 10 and 11, instead of describing the different thickness insulation feature as such, are couched in functional language as to "what it will do" so as to embrace all or any one or any combination of two or more of the four variables that determine the relative inflow of heat, viz., (1) difference in thickness, (2) difference in character, (3) difference in temperatures maintained in the two compartments, and (4) difference in temperature between the compartments and the outside atmosphere.

The Court Below Correctly Interpreted the Doctrine of Halliburton v. Walker and Properly Applied That Doctrine to the Claims in Suit.

The record in this case shows the soundness of the opinion of the Circuit Court of Appeals that the claims here involved are vague in description of the means to achieve the result (R. Vol. IV, p. 2786); that they are merely descriptive in the most general terms of the machine the patentees had in mind, (R. Vol. IV, p. 2786) and that if they achieved a patentable invention they failed to describe it with the precision required by Sec. 33, 35 U. S. C. A. (Rev. Stat. 4888), as interpreted by this Court in the *Halliburton* case (R. Vol. IV, p. 2785). The reasoning of the Circuit Court of Appeals, and its conclusion from the application of the *Halliburton* case clearly show that no other question is necessary to the decision of this case and to the denial of the petition here.

Petitioners' paragraph 3 of "Questions Presented" and point 4 of their "Reasons Relied on for the Allowance of the writs", of their "Specification of Errors and of their "Argument" (pp. 6, 8, 12, 21 to 25) accuse the court below of misinterpreting and extending the doctrine of *Halliburton* v. *Walker,* of incorrectly applying that doctrine to the claims in suit and of reaching a conclusion as to those claims which is inconsistent with its earlier decisions in *Minnesota Mining & Mfg. Co.* v. *International Plastic Corp.*, 159 F. (2d) 554, 558, and in *Gilchrist Co.* v. *Kar-Lac Co.* 29 F. (2d) 153, 154, and with this Court's decisions in *Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S. 405.

Contrary to petitioners' contentions, the court below did correctly interpret and did not extend the *Halliburton* v. *Walker* doctrine, did properly apply that doctrine to

the claims in suit and did not reach a conclusion inconsistent with those reached in the decisions mentioned.*

The court below painstakingly charted the claims in suit element by element and meticulously analyzed them to pick out the "exact point of novelty" or the "most crucial element" (Opinion R. Vol. IV. pp. 2783 to 2786). The court below then correctly found that this "exact point of novelty" or "most crucial element" was defined in language which was not "exact", but in terms "of a *result* without the statement of the *means* whereby that result is to be obtained" (Opinion, R. Vol. IV, p. 2785). In other words the "most critical element" is described in terms of "what it will do rather than in terms of its own physical characteristics or its arrangement in the new combination apparatus" (*Halliburton* v. *Walker*). Furthermore, the court below found that:

> "Nowhere in the specifications or drawings is a special kind of coil shown whose structure, such as 'finning', might be a frost-collecting deterrent. Indeed, it was agreed by the experts of all parties that a coil may be non-frosting when it is operated in one way, and become frosted if operated in another way" (Opinion, Vol. IV, p. 2785-6).

In other words the criticism of the court below of the claims in suit was directed and applied solely to the element of each which described the only point of departure from the prior art in terms of what that departure "would do" (under certain specific unexplained but not all conditions) rather than in "terms of its own physical characteristics or its arrangement in the new combination apparatus."

There is no conflict in conclusion or in doctrine between the instant case and those cited by petitioners.

---

* The clarity of the doctrine elucidated by this court in *Halliburton* v. *Walker* is attested by the fact that the court below correctly interpreted and applied it without assistance of counsel.

In the *Minnesota* v. *International* case, the court below correctly held that the *Halliburton* v. *Walker* doctrine did not apply to the claims in suit because each of the elements constituting each claim was described in terms of structure, such as (1) "a non-fibrous transparent flexible film backing having non-porous surfaces", (2) "a water-insoluble normally tacky and pressure-sensitive transparent flexible adhesive coating", and (3) "an interposed transparent primer coating".*

Each of these characteristics was structural and inherent in the element. On the contrary, "non-frosting", although unquestionably meaning above 32°F., is neither inherent nor structural nor dependent in any wise upon the arrangement of the coil in the alleged "new" combination apparatus. Non-frosting merely defines a condition or state or "what it will do" when and only when operated in some special manner which neither the specification nor the claims explains.

Gilchrist Co. v. *Kar-Lac Co.,* was decided by the court below long before the decisions of this Court in either *General Electric Co.* v. *Wabash Appliance Co.,* 304 U. S. 364, 371 or *Halliburton* v. *Walker.*** And yet the court below in *Gilchrist* v. *Kar-Lac* did not say, as petitioners intimate, that all elements of a combination claim could properly be defined in functional terms but only that "some" of them could be so defined. And, of course, under the *Halliburton* v. *Walker* doctrine that "some" could not be "the most crucial element".

In the *Continental Paper Bag* v. *Eastern Paper Bag* case

* Two typical claims of the Drew patent in suit in the *Minnesota* v. *International* case are quoted in full at page 556 of 159 F. 2d 554.

** *Halliburton* v. *Walker* is merely a fuller and more forceful exposition of the principle of and the reasons for the doctrine of *General Electric* v. *Wabash* and an unequivocal direction that the doctrine applies to "combination" claims as well as to "product" claims.

the validity of the claims was not in issue before this Court; only the issue of infringement was before it. Furthermore, as this Court pointed out in *Halliburton* v. *Walker,* the claims involved in the *Continental Paper Bag* v. *Eastern Paper Bag* case "structurally described the physical and operating relationship of all of the crucial parts of the novel combination",—a situation wholly different from that presented by the claims here in suit.

Should the Court be of opinion that any question other than the invalidity of the patents because of failure of compliance with Rev. Stat. 4888; Section 33, 35 U. S. C. A., is material, we present the following in opposition to questions 1 (Petition, p. 5), 2 and 3 (Petition, p. 6) presented by petitioner.

The Circuit Court of Appeals, on Its Own Motion, Could Notice a Plain Error in the Record, Resulting from the Failure of the Trial Court to Instruct the Jury on a Vital Issue of the Case.

For the reason that one answer suffices for both points 1 and 3 of petitioners' "Reasons Relied on for the Allowance of the Writs" and of the supporting "Argument", they will be treated together. These points likewise cover assignments 1 and 3 of the "Specification of Errors". In these points and assigned errors petitioners assert that the court below violated the Seventh Amendment to the Constitution (Petition, pp. 7, 8; Argument pp. 12, 13, 14), circumvented Rule 51 of the Rules of Civil Procedure (Argument p. 21) and disregarded decisions of this court in such cases as *Pennock* v. *Dialogue, 27 U. S. 1, 15; Klein* v. *Russell,* 86 U. S. 433, 463; *Texas & Pacific Ry. Co.* v. *Volk,* 151 U. S. 73, 78; and *Humes* v. *United States,* 170 U. S. 210, 211-2 (Petition p. 7, Argument pp. 12, 17 to 20) when it decided the vital issue of "clarity of phraseology"

against the patent claims in suit. The basis of petitioners' assertions is that no exceptions were taken to the trial court's instructions to the jury.

What petitioners overlook or ignore is that, despite the fact no error was alleged and no argument was made before the court below on the failure of the trial court to instruct the jury on the issue of "clarity of phraseology", the court below itself noticed the omission and concluded that "the issue was ignored and therefore must be decided by this court", i. e., by the court below (Opinion, R. Vol. IV, p. 2781).

Thus there is here presented not a situation where a party seeks to avail itself of an alleged error in instructions to which no exception was taken (which was the situation in the cases upon which petitioner relies) but a situation where the court below noticed a "plain error".*

There is nothing in the Seventh Amendment to the Constitution nor in Rule 51 of the Rules of Civil Procedure, nor in the decisions of this Court relied upon by petitioners which precludes a federal court of review from noticing a "plain error" even though the error is not assigned or specified, and even though the error be in a trial court's instructions to a jury.

Thus in the very recent case of *United Brotherhood of Carpenters and Joiners of America* v. *United States* 91 L. Ed. (Adv. Ops.) 705, 714 (one of several involving charges of criminal conspiracy to violate the Sherman Act) this Court reversed judgments of conviction against several defendants because of failure of the trial court

* Respondent's counsel believed at the trial, and still believe, and argued before the district court and the court below that the issue was a question of law—not of fact—on the ground that invalidity was clear upon mere construction of the claims in the light of admissions made in the file wrapper and by petitioners' own expert; and on that basis there was nothing to go to the jury and the matter of instructions was moot and immaterial.

properly to instruct the jury on the application of responsibility provisions contained in Section 6 of the Norris-LaGuardia Act (29 U. S. C. § 106); even though as to such defendants no exception had been taken to the trial court's instructions. In this connection this Court said:

> "* * * And though the failure so to charge was not excepted to, we would not be precluded from entertaining the objection" (citing cases and Rule 27 of this Court). "The erroneous charge was on a vital phase of the case and affected the substantial rights of the defendants. We have the power to notice a 'plain error' though it is not assigned or specified * * *" (citing cases).

That the same power to notice a "plain error", though not assigned or specified, is equally applicable to jury actions in civil cases is shown, for example, in *Royal Insurance Company* v. *Miller,* 199 U. S. 353, 369—an action to enforce a policy of fire insurance—where this Court said:

> "As we are at liberty, however, despite the absence of an assignment of error on the subject, to consider a plain error arising on the record, we have given our attention to the subjects referred to * * *".

The court below was equally free to notice and correct "plain error" arising on the record, where that error was a failure of the trial court to instruct the jury upon the statutory requirement for "clarity of phraseology" in patent claims (Rev. Stat. 4888). Although the rules of the Seventh Circuit Court of Appeals contain no specific rule corresponding to paragraph 6 of Rule 27 of this Court, the rules of the court below do contain a Rule 7 reading as follows:

> "The rules of the Supreme Court of the United States and the Federal Rules of Civil Procedure, whenever applicable, shall be followed."

There was no disregard by the court below of the Seventh Amendment to the Constitution nor of Rule 51 of the Rules of Civil Procedure; nor was there any disregard of or conflict with the decisions of this court cited by petitioners. On the contrary the court below followed the established practice, upon noting a "plain error" on the face of the record, of giving its attention to and deciding the issue of "clarity of phraseology".

The Court Below Correctly Ruled That No Instruction Was Given on the Issue of "Clarity of Phraseology" Under Rev. Stat. 4888.

Point 2 of petitioners' "Reasons Relied on for the Allowance of the Writs" (p. 7) and of their "Argument" (pp. 14-16) dispute the conclusion of the court below that "there was no instruction on the matter" of clarity of phraseology of the claims in suit. In support of their contention, petitioners quote on pages 15 and 16 of their brief the parts of the trial court's charge to the jury which they say constituted an adequate instruction in respect of the legal requirements of Rev. Stat. 4888 including the requirement for "clarity of phraseology".

Only a casual comparison of these quoted parts of the trial court's instructions with Rev. Stat. 4888 will suffice to show the correctness of the conclusion of the court below that there was no instruction whatsoever on the matter of "clarity of phraseology". There was not a word said in the instructions that the statute "requires the patentee to state his invention in '*such full, clear, concise and exact terms* as to enable any person skilled in the art or science to which it appertains • • • to make, construct, compound and use the same; and in the case of a machine, *he shall explain the principle* thereof, and the best mode in which he has contemplated applying that

principle, so as to distinguish it from other inventions' " (Opinion below; R. Vol. IV, p. 2779).

It is true that the trial court substantially quoted the requirement that an inventor "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery" but this was done without a word of explanation and with no application whatsoever to the claims in suit.

Furthermore, the instructions were wholly silent upon the invalidating effect of a failure of a patent to comply with all of the requirements set forth in this section of the patent statutes.

That the reading of a statute to a jury by the trial court does not *per se* amount to an instruction is the rule laid down in *Blanos* v. *Kulesva* 107 Conn. 476. In this case the Supreme Court of Errors of Connecticut held an instruction to be defective which merely quoted the pertinent section of a statute and defined a word used therein, but failed to apply the statute to the evidence in the case. The court said, at page 481:

> "It follows that the charge did not properly interpret the statute and failed to furnish the jury with adequate guidance in applying the statute to the evidence in the case."

And in the case of *United Brotherhood of Carpenters and Joiners of America* v. *United States*, 91 L. Ed. (Adv. Ops.) 705, previously mentioned, the dissenting opinion of Justice Frankfurter contains the following observation with which apparently the majority of this Court agreed because the dissent was based upon the interpretation of § 6 of the Norris-LaGuardia Act and not upon the question of the propriety of this Court considering the instructions the trial court had given to the jury:

> "• • • A trial court does not discharge its duty merely by quoting a statute relevant to the conduct of

the trial. The issue before an appellate court is not whether the trial judge might have given a request of abstract correctness, or even charged differently, but whether the judge's instructions were accurate and ample * * *" (p. 717).

Conclusion.

Petitioners have failed to sustain any of the "Reasons Relied on for the Allowance of the Writs". They have failed to show that the court below violated the Seventh Amendment to the Constitution or circumvented Rule 51 of the Rules of Civil Procedure or that its opinion conflicts with any decision of this Court. They have failed to show that the court below misinterpreted the doctrine of the *Halliburton* v. *Walker* decision of this Court or incorrectly applied that doctrine. They have failed to show that the conclusion reached by the court below in the instant case is inconsistent with conclusions reached by it or by this Court in other cases.

On the contrary Respondent has shown that the court below properly exercised its supervisory authority in noticing and considering a "plain error" in the record, and reached a correct conclusion.

The petition should be denied.

Respectfully submitted,

JOHN D. BLACK,
ALBIN C. AHLBERG,
Counsel for Respondent.

ROSS O. HINKLE,
LEON F. SHACKELL,
Of Counsel.